

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 11 and 12 have been added and claim 1 has been amended.

Claims 1-7 and 11-12 are pending and under consideration. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §103 OF CLAIMS 1-2 AND 5-7:

At page 2 of the Office Action, claims 1-2 and 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "the applicant's admitted prior art" ("AAPA") in view of U.S. Patent No. 6,577,566 issued to Tomita ("Tomita"). Applicant traverses the rejection for at least the reasons discussed herein and reconsideration is respectfully requested.

Regarding amended claim 1, the rejection is traversed because the proposed combination of AAPA and Tomita fails to suggest or disclose at least:

determining from which track the tracking error signal has been generated using the generated land/groove signal, in response to the determination that the tracking error signal has been generated

The Response to Arguments in the Advisory Action mailed April 30, 2007 asserts the feature of "determining from which track the tracking error signal has been generated" is discussed at col. 27, lines 7-19 of Tomita. There, the Advisory Action asserts that Tomita describes "when the apparatus of Tomita determines it is on a non-wobbled groove track it is determining from which track the tracking error signal is generated."

Even assuming *arguendo* that Tomita describes the feature identified in the Advisory Action, Tomita still fails to suggest or disclose "determining from which track the tracking error signal has been generated *using the generated land/groove signal*" as recited in amended independent claim 1.

Further, Applicant respectfully submits that the rejection fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP 2142*.

Here, no citation to the prior art has been offered as providing a suggestion or motivation to modify AAPA using Tomita, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the reference.

In fact, it appears the Examiner is relying on personal knowledge as the basis for the rejection. The personal knowledge of the Examiner, when used as a basis for a rejection, must be supported by an affidavit as to the specifics of the facts of that knowledge when called for by the applicant. See *MPEP 2144.03*, 37 C.F.R. § 1.104(d)(2). In short, the rules of the PTO require that the Examiner must either support this assertion with an Affidavit, or withdraw the rejection.

Accordingly, Applicant requests that the record be supported by evidence of the underlying recited motivation. The Office Action appears to take Official Notice of the underlying required motivation, while the same must be supported in the record. Without the requested support, it is submitted that the rejection is improper and should be withdrawn.

Accordingly, Applicant respectfully submits that independent claim 1 patentably distinguish over the cited reference, and should be allowable for at least the above-mentioned reasons. In addition, claims 2-7 which depend from independent claim 1 should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

REJECTION UNDER 35 U.S.C. §103 OF CLAIMS 3 AND 4:

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Tomita further considered with U.S. Patent Publication No. 2002/0054974 by Takahashi et al. ("Takahashi"). At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

Claim 3 recites at least the following:

inspecting a quality of an RF of data recorded in the land tracks in response to data being recorded only in the land tracks; and

inspecting a quality of an RF of data recorded in the groove tracks in response to data being recorded only in the groove tracks.

The current Office Action notes that neither AAPA nor Tomita discuss the above-recited features. However, the Office Action proposes to modify AAPA and Tomita, with Takahashi and asserts that Takahashi discusses the above-recited features in paragraph [100].

Takahashi describes adjusting the phase of returning light separately for the land and the groove to improve SNR. Takahashi however, does not suggest or disclose "data being recorded only in the land tracks" or "data being recorded only in the groove tracks," and Applicant asserts Takahashi cannot be relied on to implicitly teach the above-recited features merely because Takahashi describes adjusting the phase of returning light separately for the land and the groove.

Further, Applicant respectfully submits that the Office Action fails to provide a valid line of reasoning from the prior art to combine the teachings of Takahashi with AAPA and Tomita. Again, the Office Action appears to take Official Notice of the underlying required motivation, while the same must be supported in the record. Accordingly, Applicant requests that the record be supported by evidence of the underlying recited motivation, as discussed above.

Based on the foregoing, withdrawal of the 103 rejection of claim 3 is respectfully requested. Claim 4 includes similar features, with potentially differing scope and breadth, and thus is similar patentable over the cited references.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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